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Supreme Court of the United States.

OCTOBER TERM, 1881. No. 84.

GIDEON BANTZ, . . Complainant and Appellant,

vs. } From U. S. Circuit Court, Kentucky District.

DAVID FRANTZ & SONS, ... Appellees.

BRIEF FOR APPELLEES.

Patent on Wet Fuel Furnace. Reissue. Novelty. Invention.

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IN THE

Supreme Court of the United States

GIDEON BANTZ, *Complainant and Appellant,*

AGAINST

DAVID FRANTZ & SONS, - - *Appellees.*

From Circuit Court, U. S., for Kentucky District.

BRIEF FOR APPELLEES.

POINTS.

I.

A reissued patent is void where one piece of the machine originally patented is in the reissue decomposed into the parts forming the figure or outline of that piece, and separate claims are made for each part of such figure or outline.

Gill *v.* Wells, 22 Wallace, 1, 9, 10, and other authorities quoted below.

II.

The advance made by the patentee over the previous state of the art, as shown by older patents or otherwise, may be so small or so easy as not to call for the inventive faculty, and, if so, is not patentable.

Brown *v.* Piper, 91 U. S., 37; Planing Mill Co. *v.* Keith, 101 U. S. R., 490, 491, and other cases quoted below.

III.

Where the patent has expired, and the amount of damages which could be recovered from the defendants does not appear to be large, it must be a very plain case to justify a reversal of a decree of dismissal.

See Elastic Fabrics Co. *v.* Smith, 100 U. S. R., p. 110.

IV.

Claim No. 1, in Gideon Bantz's reissued patent No. 4,731, is void for want of novelty, by reason of Moses Thompson's patent of April 10, 1855.

ARGUMENT FOR APPELLEES.

The suit below was brought in equity for an injunction and account upon letters patent issued as "Reissue No. 4,731" on the 6th of February, 1872, in place of surrendered letters patent of June 22, 1858, for "An improvement in boiler furnaces for burning wet fuel." The patent was extended on the 20th of March, 1872, for seven years, from June 22, 1872. It has therefore expired long ago—not very long after the bill was dismissed below.

The suit in the circuit court was brought in the spring of 1876. An injunction was asked, but after a preliminary hearing it was refused. The bill seeks for an account of profits and damages, also for a perpetual injunction. After final hearing, on the 13th of May, 1878, it was dismissed. The complainant appeals. I respectfully insist that the decree of dismissal was right, and that, at all events, it should not now be disturbed.

In the case of the "Elastic Fabrics Co. *v.* Smith, 100 U. S. R., p. 110," it was deemed useless by this Court to wade through the merits of a patent controversy after the patent had expired, and where no substantial controversy, beyond that of costs, remained to be settled between the parties. The patent has expired ever since June 22, 1879. By his own showing the complainant can not expect to receive much more than five hundred dollars in damages and profits; at least, that is the sum with which he was satisfied in the case of "Bantz *v.* Elsas & Pritz," in the Southern District of Ohio, a case upon which he relies as a precedent for his preliminary injunction.

If in a case of this sort, where the patent has lost all interest to the patentee by its expiration, and where the sum possibly involved is only one-tenth of that of which the court takes cognizance in ordinary cases, this Court should reverse, it must be on clear grounds, and for the establishment and vindication of some important principle.

Let us, however, look at the merits of the controversy. The reissued patent, annexed to the bill of complaint, contains no less than six claims. But the complainant states that the furnace of the defendants is constructed substantially like that of Elsas & Pritz, and he files with his bill of complaint the copy of the decree which he recovered against these parties. From this decree, and from the drawings of defendants' furnace—indeed, from all the evidence in the case—it is clear that only the first and third claims of the reissue are relied on by the complainant.

The defendants, in their answer, insist on the following defenses:

First—Want of novelty in those claims, which can, in any sense, be said to have been infringed.

Second—That the reissued patent is void on its face, and on the face of the original, with which it must be compared.

Third—That the supposed invention is not useful, and is not used either by the complainant, by the defendants, or by any one else.

Fourth—The answer denies any infringement.

Other parts of the answer were drawn to meet the averments of the bill, which looked to a preliminary injunction, and are not now material.

The court below, on dismissing the bill, gave no written opinion, but intimated, as the main ground of its decision against the patent, that the step forward made by the patentee beyond the state of the art prevailing at the time of his so-called invention did not amount to a discovery or invention, within the meaning of the patent laws.

The question of reissues was the one most thoroughly discussed in the argument of the case. We relied, in the court below, mainly on Burr *v.* Duryea, Case *v.* Brown, Gill *v.* Wells, and Russell *v.* Dodge; while the complainant relied mainly on the "Corn Planter Cases." We insist, however, that any inferences which may be drawn from these cases are fully corrected, and, if need be, overruled by the later case of Russell *v.* Dodge.

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The following principles, it seems, are established by all of these cases:

1. The question of fact, whether the misdescription in the first patent arose from ignorance or mistake, as contemplated by the law authorizing reissues, or whether it was intentional, is for the Commissioner of Patents alone to decide; and his decision is binding on the courts.

2. The question, whether the invention described in the specifications and drawings of the original patent and in the reissue is the same invention, is a question which the courts alone must decide upon the face of the papers and drawings; and herein they can not be in any wise affected by the decision of the Commissioner. (Powder Co. *v.* Powder Works, 98 U. S., 126, 134, 137).

3. Where the reissued patent is larger in its scope than either the specification or the claim in the old one, it is not a patent for the same invention, and is therefore unauthorized and void.

4. When the original patent ascribes a certain effect to a piece of the proposed machine or contrivance, having a figure or outline of several sides, and the reissue ascribes the same effect to a lesser number or to one only of these sides, irrespective of the other sides, or of the form demanded for them in the original patent, the invention of the reissue is clearly different from that in the original patent, and the reissue is therefore null and void.

The tersest expression of our third proposition is found in the short opinion of Mr. Justice Grier in Case *v.* Brown, 2 Wallace, 320, decided in 1865. He disposed of the case before him in a few words:

"The plaintiff's original patent limited his claim very prop-
"erly to the particular devices and combination of parts which
"constituted his improved machine. But as this claim was not
"broad enough to cover the improvement described in defend-
"ant's patent, the plaintiff surrenders his, and had it reissued
"with a more expanded claim. It is for the infringement of
"this reissued patent that the action is brought."

The judgment below was for the defendant. Adding a few words, to which we shall soon recur, Mr. J. Grier winds up: "Let the judgment be affirmed."

In order to apply these principles properly, we must first examine the true meaning of the original claim. If this is in any way open to the construction, that the separate parts of the machine or contrivance, set forth and enumerated in it, are separate inventions, then the uncertainty may be helped out by a reissue. Of course, if the original claim was clear in its meaning, no reissue was or could be needed. We will cheerfully admit that equivocal language in the original claim should not prejudice the complainant; that if the language is equivocal, we may take refuge in a reissue in order to remedy it, as he has attempted to do.

But his claim in the old patent is preceded by the following language in the specifications (see Add'l Record, p. 33), which language throws the very clearest light upon it. (See Leggett *v.* Avery, 101 U. S. Rep., p. 257).

"My invention consists in the arrangement embracing for "united use, in the manner and for the purpose herein specified, "the following features, to-wit:

"*First.* Two or more arched fire chambers, with throats of "less area, etc.; *second*, an auxiliary combustion reservoir, or "chamber, with *cima reversa* bottom and side draft door; *third*, "a series of reverberatory chambers, with side draft door and "passages at the top, etc.; and *fourth*, a diving or direct flue, "leading into the chimney or smoke stack." (Add'l Pr. Rec.).

Let us now, in the light of this introduction, read the claim itself, as formally set out at the close of the specifications, in the old patent:

"What I claim as my invention, and desire to secure by "letters patent, is the arrangements of fire chambers *A A*, con- "tracted throats *cc*, auxiliary combustion reservoir *C*, provid- "ed with the *cima reversa* bridge plate *mn*, and the door *h*, re- "verberatory chambers *D D*, with doors *h h*, and the driving or "direct flue *E*, substantially as and for the purposes set forth." (Add'l Pr. Rec'd, p. 35.)

Nothing can be plainer than the inventor's meaning. He considers all the parts of his furnace as forming one connected whole, he does not expect any good from one part without the other. He almost disclaims the possibility of getting any benefit out of less than the whole combination. His invention consists in putting together or "in the arranging for united use" the fire chambers, contracted throats, reservoir with *cima reversa* bridge plate, and side door, and certain other chambers and a diving flue. The nature of the problem before him is how to conduct the hot gasses and vapors, resulting from the combustion of wet fuel, so they shall on their way give out the greatest amount of available heat. It is not unreasonable to lay out at once the whole road over which these gases and vapors are to travel, until they reach the open air; and to call the contrivance of this whole channel, through which they pass on their road outward, one single invention. There is nothing striking, nothing novel in any of the parts. The technical, rather high sounding names, chosen for these parts, indicate that they were long before known in the art of furnace-building. It is only for the supposed act of ingenuity of putting these well known parts together, that the complainant sought for and obtained his patent.

In the reissue these parts are disposed into five groups, and a claim is made for each of these; so that the infringement of the supposed exclusive right to each of these groups may be made a matter of complaint. In the language of Russell *v.* Dodge, 93 U. S. R., p. 460, this "operated to enlarge the character and scope of the invention."

But a sixth claim is added for so-called "dead chambers," which are not mentioned in the specifications or claim of the old issue at all, and which are found as "chambers," but by no means as dead chambers, in the drawings appended to the original patent.

"6. In a furnace for burning wet fuels, having a flat top, "and supplied through openings therein, I claim the dead "chambers, arranged between the floor and the arches of the

"fire chambers for the purpose of maintaining the top of the "furnace cool for the workingmen, as described."

Now the 53d section of the Patent Act of 1870, under which this case must be tried, a section reenacted in the Revised Statues of the United States, § 4916, and which regulates reissues, distinguishes and names separately the specification, the claim, and the drawing or model, and the Commissioner has authority to allow new matter to be introduced in some cases, either in the specifications or in the drawings, but he has no authority to admit any new matter into the claim. Moreover, this sixth claim will apply to all "wet fuel furnaces," even such as are not embraced in complainant's patent, and the existence of which he admits, and it is therefore obnoxious to the same criticism as the second claim of Russell's reissue, made upon it by this court in Russell *v.* Dodge. As long as this void sixth claim is not disclaimed, the plaintiff can not recover upon his patent. Nor indeed can it be said that the amendment or new matter was made "by the other," *i. e.* by the drawing. For the natural import of the drawing is to have open air chambers, not "dead" chambers, filled with ashes, and only intended to obstruct the passage of heat upwards, and furnish to the workman a cool spot to stand on.

Considering the small merits of the controversy as it is now brought before this Court, on the validity of a patent long since expired, we might be pardoned if we rested our claim to an affirmance on this last objection. But aside of this we maintain that the reissue is void, because its first and most important claim—the supposed invention of having "In a furnace for "burning wet fuels, having two or more single fire chambers "not arranged under the boiler, the combustive chamber or "reservoir C arranged above the top of said fire chambers, "and located directly under the front end of the boiler, essen-"tially as described" (Pr. Rec., page 9), or the supposed discovery that such an invention is useful—is on its face an entirely different invention and discovery from the "arrangement" of this, together with four other successive parts of the smoke channel for "united use."

The same may be said about the very trifling third claim of the reissue, that for the first side door.

Altogether, the contention of the complainant herein is strictly analogous to that of Russell in the case quoted. Russell took out his first patent for "treating bark-tanned sheep skin "with hot fat liquor." He found that, notwithstanding his patent, people might go on, as before, to treat bark-tanned sheep skin with cold fat liquor, or any other sheep skin with hot fat liquor. His patent was not in operation or invalid (unless, for want of novelty, appearing outside of its own language), but it was not as broad as he, in his greed, desired. And so he got it reissued, so that it should embrace the treatment of all sorts of tanned skins, with either hot or cold fat liquors. This Court said: "This result the law does not admit."

Similarly, Mr. Bantz got up his combination of four or five parts, and found that nobody would use it, not even those who paid him a royalty. He found that no one honored his invention by infringing upon it. He and all of his own witnesses admit this in their cross examination. He therefore got his patent reissued, so as to embrace in it all wet fuel furnaces, with or without *cima reversa* bridge plates or bottoms, with or without narrow throats, with or without side doors, with or without reverberatory chambers and diving flue, with or without rear wall and diving flue supporting the boiler; and finally he claims dead chambers, whether they be put in a furnace of his style or into a furnace of any other style, having first expressly admitted that other styles are in use.

But there is fortunately a precedent much closer to our case than even Russell *v.* Dodge. It is the great and well-considered case of Gill *v.* Wells, 22 Wallace, p. 1. In this, as well as in the case at bar, the invention described in the original patent embraces a channel or hollow volume, all of whose bounding surfaces make up one whole; or, in other words, the shape of this channel or hollow volume is made up and defined by the size, direction, and curvature of all these surfaces together. In each case an attempt was made, in the reissue, to separate these surfaces—to put them into separate claims.

We refer to the statement of facts in Gill *v.* Wells, 22 Wallace, pp. 9 and 10. It appears there that in the original patent for Wells' felting machine a four-sided "tunnel" was provided, through which the hair from certain revolving brushes was to be drawn by an exhausting pump to the felting frame. In the reissue this tunnel was divided into three parts—the upper "guide board," the lower guide board, and the two lateral guide boards.

Just as in that case the tunnel was provided for the passage of flying hair, so in our case the "combustive chamber," or, in plain English, a wide flue, of a given shape, is provided for the passage of gas or smoke. That there must be some sort of a flue was known before; the size and shape of this channel for the passage of gas or smoke is the only thing that the complainant could have invented. An attempt is now made to distribute the surfaces bounding this chamber, flue or channel, into separate claims. One of these, the upper, is, by inference, to be open, or to be formed only by the lower surface of the boiler, so that the burning gases may strike the boiler; this is made the main feature of the first claim. Two other surfaces, that next to the fire chamber, and the bottom—that is, the furnace wall, pierced by narrow throats, and the ascent by way of curve, which the inventor calls a *cima reversa*—are put into the second claim. But as the object of the whole chamber, the shape of which is determined by the shape of its six sides, is one, namely, so to conduct the burning gases as to get the most heat out of them for the boiler on top, it is improper to call the shape of each of its surfaces an invention by itself—just as it was held absurd to call each of the four sides of the tunnel in Wells' felting machine a separate invention, implied, but unskillfully described, in the description of the whole tunnel.

We are well aware that the language of the reissue must, in some respect, differ from the original patent, and that to confine reissues to those cases in which the original patent is "inoperative and void," in the words of the statute, on account

of vagueness, or because its language will not enable persons skilled in the art or business to work the invention, will make them very rare, and the other purpose of a reissue, that of making the claim narrower, can be more easily accomplished by a disclaimer; but there is no good reason why reissues should be frequent. In fact, this Honorable Court has, in Burr *v.* Duryea, 1 Wall., 531, and often since, reproved the frequency with which they are granted, and has intimated that in our times there is very little reason left for any resort to them, and that the application for reissues springs most often from altogether improper motives.

In the above quoted case of Brown *v.* Case, Judge Grier, in delivering the judgment of this Court, says, very drily: "It is "not necessary again to expose the fallacy of the arguments "by which these attempts (to enlarge the effect of a patent by "a reissue) are sought to be supported, though *we can not hin-* "*der their repetition.*"

Thus it is no answer to our position, that it results in making ninety-nine out of every one hundred reissues utterly worthless.

We have shown already the very pointed language in which the patentee, in his old specifications, declares the inseparable oneness of his discovery. But we must now be allowed to add that he did more; that he marked out certain features as the most important; yet these are now relegated into claims, which no one is accused of infringing upon; in short, these very features are now admitted to be without any value or importance.

Thus, in his new set of claims, he puts *first* the "reservoir" or "combustion chamber" above the top of the "fire chamber," and relegates his "cima reversa" bottom or bridge plate into another, the second claim. But in his old specifications he hardly intimates that the former chamber is to be above the latter; only the drawing shows that the combustion chamber reaches higher than the fire chamber, by the thickness of the brick arch covering the latter. The bottom and back of the reservoir are to be formed by an ascending curve, from which it may follow that this reservoir, back of the furnace proper

or fire-place, will rise somewhat higher. But the inventor cuts himself off from all pretence that the ascent in general is the main feature, and that a rise in any other way than by his chosen curve is a mere equivalent, by declaring that the throat would be closed up if "the plate was straight and set inclined." We must therefore interpret the closing words of the original claim—"substantially as and for the purposes set forth"—as limited to an ascent by the *cima reversa* curve, and as waiving and abandoning to the public every other mode of ascent. The defendants use the very "straight plate, set inclined," which the complainant has thus abandoned as being, in his view, wholly useless for his purposes. And so, again, the narrowness of the throat from the fire-room into the "combustion chamber" is described at first as very important, and as an essential quality of the fire chamber itself; this, also, is in the reissue shoved away into the second claim, alongside with the fanciful *cima reversa* bottom, and alongside with a second narrow flue that nobody seems to care for.

This Court said, in Werner *v.* King, 96 U. S., 218, 230: "Where form is of the essence of the invention, it is necessarily material." The appellant has bound himself, in his first application, to the averment that this *cima reversa* form is material, and can not now be allowed to disclaim it.

The whole object of the reissue is to get the separate claims, No. 1 and No. 3; and the evidence shows that it was suggested by the utter worthlessness of the other appliances in the original construction. Neither the plaintiff nor any of the witnesses pretends to have ever seen a furnace comprising all of the parts which were, when united, to result, according to his first specifications, to bring about the boasted results. (Pr. Rec., p. 37; *sub fine*, 40; cr. ans. 1, 2; p. 42, do.; p. 44, do.). And so, on the very eve of an extension, he took out a practically new patent, of wider scope and character; he committed that very fraud on the public which this Court has so often reproved, and no where as strongly as in the very recent case of Leggett *v.* Avery, 101 U. S. R., 256.

Mr. Justice Bradley, in speaking of the specification in Slemmons' original patent for improved plows, held by the complainant in that case, says:

"The only thing claimed was the arrangement of the two "curved shoulder beams AA, a clevis B, transverse bar Dm, "slotted adjustable handles EEb, and notched and mortised "shovels CCc, in the manner and for the purposes described. "The specification commences by saying: 'My invention "consists in the particular arrangements of the several parts in "the manner and for the purpose hereinafter described. Of "course, this was a claim for a combination of a number of par- "ticulars, and was a very narrow patent, for no one would in- "fringe it, *who did not use all the parts* of the combination as described."

The language in Bantz's original patent was very much in this form, only a little more pointed in laying stress upon the unity of the invented contrivance. It was framed by the patentee, and assented to by the Commissioner, with the sole view of protecting the combination and not its several parts.

This Court was, however, not called on in Leggett *v.* Avery, to pass upon the right of a patentee in general to break up a combination into its several parts, with claims for each separately; for the defendant's case and the voidness of the patent sued upon, was rested much more securely on the fact, that it was reissued a second time after a former reissue, and an extension, which latter had been made upon the express terms that certain claims should be disclaimed; yet this reissue attempted to revive these. Hereupon Mr. Justice Bradley uses the following very strong language, which is not at all inapplicable to the case at bar:

"We think it was a manifest error in the Commissioner, in "the reissue, to allow to the patentee a claim for an invention "different from that which was described in the surrendered "letters, and which he had thus expressly disclaimed." (P. 259).

It seems to us that in the case at bar it may be said that the ascent in the combustion chamber by any other line than the *cima reversa* curve had been expressly disclaimed, and that we

may therefore appeal to the language of Mr. J. Bradley, following close upon the above extract, in which he denounces such practices as tricky, and speaks of "stealing a march upon the public."

Before parting from this subject we may refer to the late decision of the Railway Co. *v.* Sayles, 97 U. S., 554, 563, in which the principles limiting reissues were applied, and by such application reaffirmed, to amendments made during the pendency of the original application. Says this Court: "It will "be observed that we have given particular attention to the "original application, drawings, and models filed in the Patent "Office by Thompson & Bachelder. We have deemed it proper "to do this, because if the amended application and model, "filed by Tanner five years later, embodied any material addi- "tion to or variance from the original—anything new that was "not comprised in that—such addition or variance can not be "sustained on the original application. The law does not per- "mit such enlargements of an original specification, which "would interfere with other inventors who have entered the "field in the meantime, any more than it does *in the case of* "*reissues of patents* previously granted."

Let us, however, look at these two claims as if they stood in the original patent. Both are, I maintain, void for want of novelty, and claim No. 3, moreover, for triviality. Neither of them, when the known state of the art is applied to them, show any exercise of the inventive faculty.

The defense of the want of novelty is put in the answer upon two grounds: first, the prior existence of Moses Thompson's patent, which was granted on the 10th of April, 1855, upon an application made in 1853; secondly, the use by one of the defendants, together with his former partners, that is, by the predecessors of the present firm, in the very tannery now occupied by the latter. Neither of these two grounds had been asserted in the suit brought by the appellant against Elsas & Pritz in the Southern District of Ohio, and it is not to

be wondered, therefore, that he was successful in that litigation.

We rely mainly upon the first of these grounds—the Thompson patent, which, together with its file wrapper, are embodied in the present record. I shall now proceed to compare the first claim of the reissued patent of the appellant with the specifications of Moses Thompson, throwing such light upon the latter as is furnished by the different documents of his file wrapper.

The first claim of the appellant's reissued patent reads thus: "In a furnace for burning wet fuels, having two or more single "fire-chambers not arranged under the boiler, the combustion "chamber or reservoir C arranged above the top of said fire "chambers, and located directly under the front end of said "boiler, essentially as described." (Pr. Rec., p. 9.)

Take first opening words: "In a furnace for burning wet fuels, "having two or more single fire-chambers not arranged under "the boiler." He admits that there were such furnaces prior to his own, and with Moses Thompson's patent lying before him he could not well deny or ignore the fact. This patent was applied for in November, 1853, nearly a year before the appellant claims to have made his invention, or to have applied for his own patent. By his own showing his application was not made earlier than 1854.

The drawing (fig. 2), which accompanies Thompson's patent (see printed record, page 57), shows a dumping hole, marked D (which corresponds to the dumping holes *dd* in Bantz's patent) in the top of each fire-chamber. It follows that Thompson's invention was, in case the furnace was used to heat a steam boiler, which was one of the purposes contemplated, as he states fully in his specifications, to have "*his fire-chambers not arranged under the boiler,*" to use the words of appellant's first claim.

The next words of this claim are: "The combustion chamber or reservoir C." The cross flue F of Moses Thompson, marked F, is just such a reservoir or combustion chamber; it is a place

wherein to burn the smoke, vapors or gases, escaping from the fire-chamber. This was expressly so adjudged by the Commissioner of Patents, in his final opinion, upon an appeal from an office rejection, when he granted Thompson's application. He says:

"It is well known that the smoke and gases evolved when "wet or green fuel is added to any fire, are, to a considerable "extent, combustible. To effect this object (*i. e.*, to burn "them) various contrivances have been suggested; we are "now considering one of this character." (Printed Record, p. 63.)

We have it thus upon record, long before the appellant got his patent, not only in the specifications of Thompson, but also in the opinion of the Commissioner, that a "combustion chamber or reservoir" behind a wet fuel furnace is a useful thing, and that it is to be found in Thompson's furnace. So far, therefore, we have found nothing novel in appellant's claim.

Further on the Commissioner says: "The flues from these furnaces are united at their (the furnaces) rear extremity, so that when fresh fuel is added to one of the furnaces, the smoke and gases evolved, uniting with the flame, etc., become completely consumed." Pr. Rec., ibid.) It is thus established by the highest authority, and one which is quasi-judicial and presumably impartial, that the very flue, which, in the opinion of Frank Millward, the appellant's expert witness, is not a combustion chamber, is one nevertheless. Thompson himself always considered it such: for in his original application (Pr. Rec., p. 59) he says: "And further combustion will take place in the flue F."

True it is, that Thompson held some erroneous notions about the decomposition of water in the presence of strong heat, which led him to the belief, that in a furnace constructed like his own, wet would actually be preferable to dry fuel, but these notions, as the Commissioner of Patents justly remarked, do not lessen the usefulness of his apparatus to those men, who have in the nature of their trade (such as tanning or sugar boil-

ing) a great deal of wet fuel on hand, which they would like to dispose of profitably.

Aside of this opinion of the Commissioner of Patents, which is valuable as that of the man who is stamped by authority as the foremost expert of the country, the same fact has been solemnly declared by Mr. Justice Hunt, on the Circuit in the Northern District of New York, in the case of C. N. Black, Administrator of Moses Thompson *v.* Sam. Thom. His language, which I have copied from one of the printed volumes containing the record of that hotly contested case, is this: "That the construction and operation of the *mixing chamber* "was the elemental idea of the patent (Moses Thompson's); "that it was an improved machine, by which the principle of "mixing and applying the different heated gases is carried "out."

Wherein, indeed, lies the difference between Thompson's flue and complainant's "reservoir," aside from the plain English name of the former, and the Frenchified appellation bestowed upon the latter? Only in this, according to the testimony of Millward, the expert, in his third and last deposition, answers to cross-questions 15 and 16, that he estimates the cross-section of the former at one square foot, that of the latter at two square feet. (Pr. Rec., p. 53.) But as neither patent makes a point of the size of the chamber, the latter patentee cannot claim the difference in size, which is merely indicated in his drawing, as something novel. Mr. Millward, in his testimony, indeed, refers also to the peculiar formation of Bantz's chamber; but, fortunately for us, the claim for this formation has been relegated to another claim, and we are not charged with having imitated this peculiar formation, the famous *cima reversa*, at all.

The next words of appellant's first claim are: "Arranged "above the top of said fire chambers." Taking the word "above" in its usual meaning, and testing it by appellant's drawing (Pr. Rec., p. 10), this is simply untrue—just as untrue as if somebody, looking at the map of Europe, would say that

Germany lies north of France; or, looking at the map of the United States, would say that Iowa lies north of Illinois. The bottom of the reservoir sits a little higher than that of the fire chamber, and the former reaches somewhat higher up than the latter, but it is not arranged above it. The same relative position of parts can be affirmed of the furnace patented by Thompson. In the drawing attached to his patent (Fig. 2; see Pr. Rec., p. 57) it appears plainly that the flue F begins higher, and that it also runs up somewhat higher than the fire chamber A, just as C, the mixing chamber of complainant, begins higher and reaches higher than his fire chamber A. In neither case is the word "above" strictly applicable; in each it may be used, if it is a synonym for the words "higher than." Taken altogether, as the drawings stand, it seems that the center of the combustion chamber rises over the center of the fire chamber a little more in the Thompson furnace than in that of Bantz.

The latter seems to be quite proud of his supposed great discovery, that the natural *upward* draft for smoke and gases should not be hindered, and boasts that it has been left free in the construction of his furnace. (Pr. Rec., p. 8, *sub fine*). But Moses Thompson was just as wise; see his application (Pr. Rec., p. 59, D), where he says: "The thing to be heated "ought to be so high as not to require the products of com- "bustion to descend on their passage to it."

Appellant's first claim proceeds thus:

"*And located directly under the front end of the boiler.*"

This is just as applicable to Thompson's furnace as to that of the appellant. The only difference is that in the drawing Thompson's flue appears covered with a thin brick arch, while that of the appellant is open on top. But by reference to Thompson's specifications, it appears that when the furnace is used for the purpose of heating a steam boiler, the long flue (I) must be made of the proper size to envelop the boiler; and if any one chose to move the boiler forward over F, the short cross flue, of which Thompson's leaves to the furnace-owner

the free option, this brick arch will, of course, be taken off. (Pr. Rec., p. 59). And it seems, from the evidence (Pr. Rec., p. 41, ans. 11), that the furnace at the defendant's tannery was built, in this respect, exactly like the appellant's patent long before that patent was granted.

I shall hereafter recur to the supposed novelty and inventiveness in locating the fire and combustion chambers, or what is, in effect, the same thing, in locating the boiler. Excepting this alone, we have shown above that every single word of the complainant's first claim is anticipated by Moses Thompson. And we wish to remark, before taking leave of Thompson's file wrapper, that the strictness with which his application was scanned contrasts rather favorably, we might say sadly, with the looseness that must have prevailed at that subsequent time, when the complainant obtained his reissue—a loose management which not only overlooked the want of novelty in the first patent, but also the illegality of breaking up an implement or contrivance into its constituent parts, and a figure into the lines which together only determine its shape. The courts, as Mr. Justice Grier well said in Case *v.* Brown, can not prevent the repetition of these attempts of a grasping, wrongful monopoly to clothe itself in the semblance of national authority; but they can at least see to it that these attempts do not ripen into the victories of chicane over honest thrift.

* * One clause of the appellant's first claim, comprising the words "located directly under the front end of the boiler," still remains. And I have still to discuss the validity of the appellant's third claim, as set forth in his reissue:

"In combination with the combustion chamber or reservoir "C, arranged and located as described, I claim the side door "or doors *h*, for the admission of atmospheric air for the pur- "pose described." (Pr. Rec., p. 9.)

This third claim is for more than one reason absurd. Side doors, as the appellant and his witnesses admit, have been used in cooking stoves, time out of mind, and there is no need for inventiveness and no room for invention in putting

side doors also in any other kinds of stoves, ovens or furnaces, for the same service and purpose, that is for taking out soot and ashes. The proof shows that they will serve this purpose in either kitchen stove or furnace, and that they are useless for anything else in one or the other. And that they certainly will not perform the uses claimed for them in the patent. (Pr. Rec., p. 28, ans. 18.)

While reviewing, in their bearing on this third claim, the principles and cases as to the voidness of patents granted for trivial inventions, or for processes or fabrics notoriously in use, or for the mere application of old contrivances to new uses, I must, at the same time, throw light on the other question: how far the appellant's suggestion in the words of the first claim, "located directly under the front end of the boiler," can be deemed an inventive, forward step, worthy of the protection of the patent laws.

The leading decision, that the mere application of an old process or machine to a new or similar use is not patentable, is Robertson *v.* Ryer, 91, U. S., 150 ("it is no new invention "to use an old machine for a new purpose"—syllabus). Nearly akin to this are the decisions, both in the last named volume, of Brown *v.* Piper, 91 U. S., 37, and Sewell *v.* Jones, *ib.* 171: the well-known fish preserving and canned corn cases. In the former of these it was also held, that where a process or machine has long been in general use, no notice of the times and places of particular use need be given, but the want of novelty may be proved at law under the general issue, in equity under a general averment of want of novelty in the answer. In Terhune *v.* Phillips, 99 U. S., 592, 593, this court went even a step further. I quote Mr. Justice Swayne's opinion in full: "The determination of this case is controlled by "Brown et al. *v.* Piper, 91 U. S., 37. We cannot fail to take "judicial notice that the thing patented was known and in gen- "eral use long before the issuing of the patent. The sub- "stitution of metal for wood was destitute of both patentable "invention and of utility. The admission of improper testi-

"mony, if it occurred, was, therefore, immaterial. The case "of the appellant, as it appears in the record, without any "testimony, is clear and conclusively against him."

For the want of sufficient inventiveness, this Court has invalidated the letters patent relied on in several other cases. In Roemer *v.* Simon, 95 U. S., 214, 217, it was said that a slight improvement or variation, which "any mechanic" furnished with the materials might have added, is not a sufficient novelty to sustain a patent. In the Glue Company *v.* Upton, 97 U. S., p. 3, a patent granted for a method of breaking up glue into small particles, readily soluble and putting it up in this shape for commerce, was held invalid. The general principle is best laid down in Smith *v.* Nichols, 21 Wall., 112, 119: "A mere carrying forward or new or more extended "application of the original thought, a change only in form, "portions or degree, the substitution of equivalents, doing "substantially the same thing in the same way by substantially "the same means, with better results, is not such an invention "as will sustain a patent."

In Dunbar *v.* Myers, 94 U. S., p. 187, Mr. Justice Clifford, after stating that the device of covering a circular saw with one deflecting plate was old, speaks thus of the appellee's claim to the pretended invention of arming the saw with two such deflecting plates:

"Grant that two such plates are, in certain cases, better "than one used alone, still the question arises whether it in- "volves any invention to add the second plate to a machine "already constructed with one plate. Beyond doubt, every "operator who had used a machine having one deflecting "plate knew full well what the function was that the deflecting "plate was designed to accomplish, etc. Ordinary mechanics ". . . . would know how to arrange a deflecting plate at one "side of a circular saw which had such a device properly ar- "ranged on the other side, etc."

The learned judge concluded that the patentee, at least, as to this claim, was not an "inventor" within the meaning of the Constitution and of the patent laws.

After an ordinary mechanic had tried Moses Thompson's suggestion, that it would be best to put his boiler altogether in the long flue I, he would naturally, when he saw that he was losing part of the heat engendered, push its front end forward upon the cross-flue F.

This is followed up in the very late case of the Planing Machine Company *v.* Keith, 101 U. S. R., pp. 490, 491: "Mere enlargement is not invention. The simplest mechanic "can make such a modification. The third principal objection "urged by the appellant is that the Anson machine fails as a "whole to perform the functions of the Woodbury machine. "If by this is meant that heavy plank cannot be planed by it, "the objection is well taken. For such a purpose it would "need enlargement and strengthening; but that all the ele- "ments claimed for the patentee's combination are found in it, "producing the same results, differing only in degree, if at all, "is to us very apparent."

The Court below (the late very learned District Judge presiding), while hardly paying any attention to the trifling third claim, arrived at its conclusion to dismiss the bill, as based on the first claim of the reissue, by the following course of reasoning: The only difference between Moses Thompson's furnace, with a boiler put upon it, and the furnace and boiler described in appellant's first claim, is this: that the former advised those using his furnace to place the boiler back of his "cross flue," which corresponds to appellant's combustion chamber, while the latter insists that the boiler should rest with its front end on that very combustion chamber, forming its roof and reaching forward to the fire chamber. The improvement suggested by the appellant is somewhat of the kind, as finding the best place on a stove where to put your pot or kettle for boiling your soup. It is one of the steps in improvement which do not call forth the inventive faculty, which are, in fact, not inventions, and which, therefore, are not patentable. At the time when the late Judge Ballard expressed those views, this court had not yet rendered its judgment in Planing Machine Com-

pany *v.* Keith, above referred to, which so thoroughly sustains him.

When Thompson drew the specifications for his wet fuel furnace, he contemplated that it might be used for the purpose of raising steam, as well as for many other objects. He says: "If the furnace is used for generating steam, the best place "for the boiler is in the flue I, which will be made of proper "size to receive and nearly surround it." Mark the word "nearly." As everybody knows that a boiler is put over, not under, the fire or hot gases, this means of course that the boiler is to fill the upper part of the flue I, and that it will not be separated by any brick arch from the flame or hot gases. By saying that this is the best place, Thompson draws the furnace builders' attention to the importance of looking for the best place. There are only two alternatives: either to push the front end of the boiler forward over the cross-flue F, like the appellant did, or to put it backward, so as to make it cover the long flue I only. Of the two alternatives, Thompson has advised those using his furnace to choose the one, which I am willing to admit is the worse. But he who acts otherwise does not thereby reject Thompson's patent. His attention has been drawn to the problem of finding the true place for the boiler. To find the right place, or rather the best place, as the Circuit Court properly held, is not the subject either of patentable invention or of infringement.

Let us apply the facts, as proved, to the claim of the side doors. One of defendants' witnesses, Lawrence Pratt, states (Pr. Rec., p. 30, ans. 11), after having fixed the year 1856 as the time when their old furnace was set up, and Thompson as the man who did it:

"There were three doors on one side, on the right side of "the boiler when you stand on the front. The first door was "to cool off, right next to the front. The other two were to "clean out the ashes." This, then, happened before the defendants could have learned the appellant's great invention; and Thompson seemed to consider these side doors as a natural

incident of the furnaces which he was setting up for a royalty under his patent. They were a sort of necessity; they obtruded themselves; it was not necessary to invent them. Why, then, did he not specify these side doors in his schedule? Why did he not claim them, like the appellant does?

This question reminds me of the question which Don Quixote, on his travels, put to the first inn-keeper at whose castle he alighted, and to the answer which he obtained. The Knight of the Sad Countenance had not taken either money or clean shirts with him, because he had never read in his books of chivalry that knight-errants troubled themselves about money, or that they encumbered themselves with baggage. The inn-keeper told him that they always carried both money and clean shirts. Why, then, asked the Knight, don't the books tell us of this. Because, said the inn-keeper, this is a matter of course, which everybody should take for granted without being told.

Exactly thus. Thompson never took the trouble to have a side view drawing made of his long flue, with side doors in it, for cooling off, or for taking out the soot and ashes—taking it for granted that every practical mechanic, when he came to construct his furnace, would know where to put these side doors, as well as the mud drum. Having made some substantial progress in the art, he did not trouble himself about securing a patent on such trifling details. On the other hand, the plaintiff, Bantz, after a lapse of twenty years, in which nobody seems to have paid the slightest attention to his grand discovery, falls back on the wonderful contrivance that, in order to take out ashes and allow heat to escape from a furnace, you must have a door.

The only good use which these side doors have accomplished in this controversy is to establish the fact that Mr. Frank Millward, the expert witness employed by the appellant (peace be to his ashes!), was, like most others of his (the expert) breed, a most arrant humbug. Notwithstanding his training in physics and mechanics, he either did not know, or did not want to

know, as much about the management of a fire as an ordinary cook or janitor, viz.: that the opening of any side aperture breaks the force of the draft, and naturally damps the blaze. After pondering and seeking to avoid cross questions 5 and 6 (Pr. Rec., p. 25), he is at last cornered by cross question 7, falls into the trap, and tells us in high-sounding phrases "the "tendency (of letting in air by the side door) would be to in- "crease combustion, and consequently increase the draft, as it "is called." Any old cook knows better.

That Millward knew nothing of wet fuel furnaces, and had never seen one except when he was employed to testify (cross questions 15 and 16); had never seen any patent except the plaintiff's reissue (cross question 17); had never even seen Thompson's patent, on which defendants rely (cross question 8), till he is expressly employed to study it, so that he may give a new deposition upon it, is not to be wondered at. This is only the ordinary style of mechanical experts. The big phrases with which he sought to cover up his ignorance, quite overlooking the existence of such a thing as an Anglo-Saxon element in the English language, will not impose upon the judges of this Court, to whom this jargon is not new.

And so his depositions may be thrown out, on the simple ground that he is neither an eye-witness, nor an expert; and that his opinion is worth neither more nor less than that of the first best man or woman we meet on the street, unless that man or woman happened to be a cook, when Millward's opinion would be worth decidedly less.

Curtis, in his Law of Patents, sec. 490, says: "The most "skillful and scientific mechanician in the world can only say "what, in his opinion, are the differences or resemblances "between one machine and another, and how far they are re- "garded by mechanicians as material and substantial. But the "question of what constitutes a fresh invention, or what upon "a given state of facts amounts to a change so great as to "support an independent patent for a new thing, is a question "of law." That is, the court can not take the conclusions of

men giving their mere opinions under the guise of testimony; but it must form and give its own conclusions.

A very slight glance at claims 2, 4 and 5 in appellant's reissue (Pr. Rec., p. 9) will show that they are all based on combinations, some elements of each of which are clearly absent in appellees' furnace. It is, therefore, needless to go into any detailed examination of these claims.

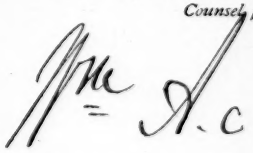
Before closing, I wish to refer again shortly to claim 6 of the reissue. If, for the reasons indicated above, this claim is improper in the reissue, the whole reissued patent must fall to the ground; for § 4917 gives its saving virtue only to the good parts or claims of those patents, of which other parts are void for want of novelty; not to those of which a part is claimed in defiance of the rules of reissue prescribed in the preceding section.

Upon any of the grounds enumerated at the head of this brief this Court would be justified in affirming the judgment of dismission rendered below. If the merits are entered upon, the analogy of the case at bar with Gill *v.* Wells will most speedily and clearly dispose of it in my clients' favor.

Respectfully submitted,

LEWIS N. DEMBITZ,

Counsel for Appellees.



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Respectfully submitted,

LEWIS N. DEMBITZ,

Counsel for Appellees.

ADDENDA—REPLY TO APPELLANT.

On the subject of what is an insufficient exercise of inventive skill, to deserve a patent, I should add to the authorities quoted on pages 19–22 of my brief, a reference to what this Court said in the Cornplanter Cases, 23 Wall., pages 230 and 232, as to reissued patents 1092 and 1094; especially these words: "It can hardly be contended that the proper *location* of the seat for effecting the same object, required the exercise of inventive power."

As to the effect of Moses Thompson's patent in our case, under the rules of practice and evidence, I contend that it was spoken of and referred to as an exhibit in the answer, and that the requirements of the law that notice of prior patents or prior use must be given was fully complied with. Under the rules of equity, exhibits may always be produced and proved *ore tenus* at the hearing. The court below could not have excluded the patent, even if its own irregular conduct, in hearing at Louisville cases set on the Covington docket, had not led naturally to the neglect of a regular filing of the papers at the more ordinary time. This Court will never reverse, because the court below has in its discretion allowed one of the parties additional time for completing his evidence.

Appellant traces his history back to 1848, through a number of experiments on dry bark, which are wholly from the purpose, and of experiments on wet bark, which are also irrelevant as long as they are not successful. There is nothing in all this history to deprive Thompson of the priority in all that his claims cover. The aid which Bantz gave to Thompson in obtaining his patent can not aid, but must estop the former.

On the matter of the reissue the appellant grapples pretty well with the various parts of the original furnace, which are a mere aggregate, he says, not a combination (though they form together but the one channel for the smoke or gases issuing from the fire channels); but he fails necessarily to show how his "combustion chamber" is only an aggregate, not a combination of the six walls that form it, and merely an aggregate. Thus he can not excuse the omission of the "cima reversa" and the substitution of that "inclined plane" which in the original patent was expressly denounced as worthless, and thus he can not get himself out of the exact analogy of Gill *vs.* Wells.

Respectfully,

L. N. D.

Bantz vs. Frantz. - S.C. U.S.

Addenda to Appellee's Brief.

Since our Brief was printed the 103rd Volume of U.S. Reports has come out & the case of Manufacturing Co. vs Corbin, reported at page 786 of that volume, this Court reaffirms its older doctrine on reissues, which had been shaken by the Complainant's cases, so emphatically - every reissue void, if broader than the original letters (pp 791 and fin) - that there is no further room for discussion on this branch of the subject. The decree dismissing the bill must be affirmed, if, for no other reason, because the first claim of the reissued patent covers a combustion chamber of any shape, while the original letters covered it only when it had the cima reversa bottom. Hence the reissued patent is broader than the old one and consequently void.

Respy L. H. D. Counsel

JAN 10 1882

IN THE

Supreme Court of the United States.

GIDEON BANTZ
vs.
D. FRANTZ & SONS.

Last Addenda to Appellees' Brief.

As the undersigned counsel will have no opportunity for speaking in this case, he wishes to add a few words to his former briefs. It is not necessary now to point out more fully the details of the evidence: how Thompson's furnace might be made up with two fire chambers only, and not as appellant conceives, with three at least; how the firm preceding the appellees in their present tannery used, before the alleged invention of Bantz, those side doors in the rear of the furnace which he claims as new; or how, by the evidence of witnesses to the fact, these side doors served an entirely different purpose from that ascribed to them by the appellant's pretended expert, and would not serve that purpose at all. All this may be put aside in view of the late decisions of this court on the controlling question, that of reissue, which were published in 102d and 103d U. S.—(Ball vs. Langles, 102 U. S., p. 128; Manufacturing Co., vs. Ladd, Ibid., p. 408; and Manufacturing Company vs. Corbin, 103 U. S., p. 786.) The words of the last-named decision (p. 791) declare "every reissue void, if broader than the original letter." This at once

destroys the first and most important claim of the reissued patent sued upon, for it seeks protection for every combustion chamber in a wet-fuel furnace, while the original patent covers only (Rec., p. 35) an "auxiliary combustion reservoir C, provided with the cima revusa bridge-plate *mn* and the door *h'*."

But the opinion of this court rendered in the case of Miller vs. Bridgeport Brass Co., at the present term, though it seemingly limits the strong language of the last-named case, really gives even greater force to it. The court has at last swept away the feeble fiction of believing in the impossible, and it will no longer, even upon the say-so of the Commissioner of Patents, take it for granted that for twelve or fourteen long years nothing but the patentee's "mistake and inadvertence" has kept him from claiming all of his real invention. In this case the delay from the original to the reissue was no less than thirteen years and seven and a half months. Thus for more than *two* years the separate, uncombined features of the so-called invention had been abandoned to the public. After this they can no longer be recalled. There was an extension, which must have been granted on the ground that little or no profit was derived from the original patent; hence, also, the fraudulent reissue.

The opinion in Miller vs. Brass Co. will at last achieve the result for which Mr. Justice Grier struggled in vain when he decided Case vs. Brown.

It would be needless after this, to encroach on your time with a speech on this threadbare subject.

Respectfully submitted,

LEWIS N. DEMBITZ,
Counsel for Appellees.